

Statement of Common Ownership:

U.S. Patent Application Serial No. 09/752,861 and U.S. Patent No. 6,701,421 to *Elnozahy et al.* were, at the time the invention of Application Serial No. 09/752,861 was made, owned by International Business Machines Corporation.

REMARKS

In the Office Action dated February 27, 2007, claims 1-13 and 16-28 were presented for examination. Claims 19-20 were rejected under 35 U.S.C. §112, second paragraph. Claims 1-13, and 16-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Elnozahy et al.*, U.S. Patent No. 6,701,421, in view of *Sayles*, U.S. Patent No. 6,549,963.

I. Rejection of Claims 19 and 20 under 35 U.S.C. §112

In the Office Action dated February 27, 2007, the Examiner rejected claims 19 and 20 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, the Examiner indicated that there is no antecedent basis for “said shared cache descriptor”. Applicants have amended claim 19 to provide proper antecedent basis and to correct this element of indefiniteness. Accordingly, Applicants respectfully request that the Examiner remove the rejection of claims 19-20.

II. Rejection of Claims 1-28 under 35 U.S.C. §103(a)

In the Office Action dated February 27, 2007, the Examiner rejected claims 1-13 and 16-28 under 35 U.S.C. §103(a) over *Elnozahy et al.* in view of *Sayles*.

The remarks pertaining to *Elnozahy et al.* and *Sayles* in the prior communications are hereby incorporated by reference.

Applicants have submitted a statement of common ownership pursuant to MPEP §706.02(l)(1) as evidence of common ownership between *Elnozahy et al.* and the pending application of Applicants.

U.S. Patent Application No. 6,701,421 to *Elnozahy et al.* was filed before the U.S. Patent and Trademark Office on August 17, 2000. As noted in the Statement of Common

Ownership, *Elnozahy et al.* is owned by International Business Machines Corporation and *Elnozahy et al.* and U.S. Patent Application Serial No. 09/752,861 were commonly owned by International Business Machines Corporation at the time of the invention. Applicants filed their application before the U.S. Patent and Trademark Office on December 28, 2000, and each of the Applicants have assigned their rights to International Business Machines Corporation.

Under 35 U.S.C. §103(c),

“Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

In the outstanding Office Action, the Examiner did not dispute Applicants’ position that *Elnozahy et al.* does not qualify as a prior art reference under 35 U.S.C. §102(b), and therefore should have been cited under subsection 102(e). As such, it is clear in the record that the current prior art rejection falls under the exemption for commonly owned patents and applications set forth in 35 U.S.C. §103©. Accordingly, Applicants respectfully request removal of the rejection of claims 1-13 and 16-28 under 35 U.S.C. §103(a).

III. Conclusion

Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicants request that the Examiner indicate allowability of claims 1-13 and 16-28, and that the application pass to issue. If the Examiner believes, for any reason, that personal communication will expedite prosecution of the application, the Examiner is hereby invited to telephone the undersigned at the number provided.

In light of the foregoing amendments and remarks, all of the claims now presented are in condition for allowance, and Applicant respectfully requests that the outstanding rejections be

withdrawn and this application be passed to issue.

Respectfully submitted,

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